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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,053	09/27/1999	RICHARD L. PALINKAS	D-6394	2219

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EXAMINER

PEZZLO, BENJAMIN A

ART UNIT PAPER NUMBER

3613

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/407,053

Applicant(s)

PALINKAS, RICHARD L.

Examiner

Benjamin A Pezzlo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15,17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-873) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-52)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the meaning of "special" in line 9 is unclear.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlston.

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one spring in the shape of a "special" toroidal shape ("special" in the sense that

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while having an external toroidal profile, the biasing means is nonetheless hollow and thus, "special") positioned within the first housing bore, for urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

Re claim 19, see Carlston: springs 36, 38 in Fig. 2.

Re claim 20, see Carlston: "plate" 75 in Fig. 2.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8, 10-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079) in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a bearing pad assembly including a first housing 56 having an exterior surface and defining a bore extending at least part way through the first housing, a first load bearing member coupled to the housing (col. 3 lines 32-34) and defining an outwardly facing first abutment surface and a second housing 32 defining a bore of a shape similar to the exterior surface of the first housing and adapted to slidably receive the first housing therein, a second bearing member 42 coupled to the second housing and defining an outwardly facing second

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abutment surface opposite to the first abutment surface (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring 36 positioned within the first housing bore, wherein the compression spring comprises a resilient material having a toroidal shape for urging the first and second load bearing members away from one another in response to a load being imposed upon at least one of the first and second abutment surfaces.

Carlston does not disclose the toroidal compression spring being solid. Magowan discloses a solid toroidal compression spring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a solid toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13).

Carlston in view of Magowan do not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirable to "permit sliding of the top

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cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirable to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 3, see Fig. 3 of Carlston.

Re claim 4, see above.

Re claims 5-6, see Carlston: col. 2 lines 19-26.

Re claim 7, see Carlston: Fig. 6.

Re claim 8, see Carlston: Fig. 2.

Re claims 10-11, see generally Platkiewicz et al. col. 3 lines 2-6 and col. 1 lines 19-23.

Re claim 12, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

Re claim 13, see Platkiewicz et al. col. 3 line 63.

Re claim 14, see Platkiewicz et al. col. 3 line 64.

Re claim 17, see Carlston, Fig. 2.

Re claim 18, see Magowen, Fig. 2.

6. Claims 15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079).

Please note that the present rejection is provided to address potential alternative meanings of the term "special".

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Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring positioned within the first housing bore, for urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

Carlston does not disclose the toroidal biasing means being "special". Assuming "special" is intended to mean a solid toroid, Magowan discloses such a toroid. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a "special" toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13).

Re claim 19, see Carlston: Fig. 2.

Re claim 20, see Carlston: Fig. 2, "plate" 75.

7. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one spring in the shape of a "special" toroidal shape ("special" in the sense that while having an external toroidal profile, the biasing means is nonetheless hollow and thus, "special") positioned within the first housing bore, for urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

Carlston does not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirable to "permit sliding of the top cap member around



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the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirous to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 22, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

8. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079) in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Please note that the present rejection is provided to address potential alternative meanings of the term "special".

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring positioned within the first housing bore, for urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

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Carlston does not disclose the toroidal biasing means being "special". Assuming "special" is intended to mean a solid toroid, Magowan discloses such a toroid. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a "special" toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13).

Carlston in view of Magowan does not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirable to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirable to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 22, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

### ***Double Patenting***

9 Applicant is advised that should claim 1 be found allowable, claim 4 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Response to Arguments***

10. Applicant's arguments filed 5 December 2001 have been fully considered but they are not persuasive.

Applicant states, "Carlston lacks a toroidal shaped compression spring". This simple statement obfuscates the issue of what constitutes the claimed "special toroidal shape ring" (see claim 15 line 9). Since Applicant does not define what "special" is, the Examiner has interpreted this term according to its broadest reasonable interpretation, that is, to mean a hollow toroid shaped ring such as that disclosed by Carlston.

In response to Applicants argument that a combination of Carlston and Magowan is improper because a core would not work with a solid toroid, please see Magowan who shows in Fig. 2, a core (A) in combination with a solid toroid (B).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In addition to the reasons set forth in this Office Action, Applicant's attention is kindly drawn to Fig. 6 of Curtis et al. As Applicant admits, Curtis et al. employ the spacers shown in Fig. 6 to *facilitate sliding* of the top cap member around the sleeve member. This is the essence of a slip lining and even though Curtis et al. don't employ solid toroids in their device, they provide motivation to use slip linings (such as those disclosed by Platkiewicz et al.) in bearing pad assemblies which do.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Berends and Nicoles disclose further related devices.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A Pezzlo whose telephone number is (703) 306-4617. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Schwartz can be reached on (703) 308-2569. The fax phone numbers for the

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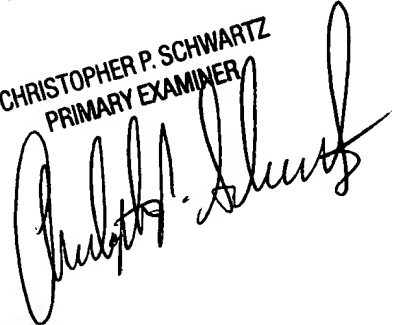
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organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BAP  
January 13, 2002

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Christopher P. Schwartz", written over the printed name and title.